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Due Date: May 14, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
Inventor: Gregory J. Gagnon et al.)	Examiner: Robert E. Rhode, Jr.
)	
Serial #: 09/726,368)	Group Art Unit: 3625
)	
Filed: November 29, 2000)	Appeal No.: _____
)	
<u>Title: PAY TV BILLING SYSTEM ACTIVATION</u>)	
<u>AND E-COMMERCE USING A PAY-TV</u>)	
<u>RECEIVER</u>)	

BRIEF OF APPELLANTS

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR §41.37, Appellants hereby submit the Appellants' Brief on Appeal from the final rejection in the above-identified application, as set forth in the Office Action dated December 14, 2005.

Please charge the amount of \$160.00 to cover the required fee for filing this Appeal Brief as set forth under 37 CFR §41.37(a)(2) and 37 CFR §41.20(b)(2) to Deposit Account No. 50-0494 of Gates & Cooper LLP. The fee of \$160.00 is the remaining fee from a previously filed Appeal Brief fee of \$340.00 on October 18, 2004. Also, please charge any additional fees or credit any overpayments to Deposit Account No. 50-0494.

Adjustment date: 05/16/2005 YPOLITE1
10/22/2004 MJONES1 00000001 500494 09726368
01 FC:1402 340.00 CR

05/16/2005 YPOLITE1 00000016 500494 09726368
01 FC:1402 500.00 DA

I. REAL PARTY IN INTEREST

The real party in interest is Hughes Electronics Corporation, the assignee of the present application.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

III. STATUS OF CLAIMS

Claims 6-7, 21-22, and 36-37 have been cancelled.

Claims 1-5, 8-20, 23-35, and 38-52 are pending.

Claims 1-9, 11-24, 26-39, and 41-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis (US 6,275,268 B1) in view of Nel (US 6,363,364 B1) and further in view of Chatterjee (EP 0820206 A2).

Claims 10, 25, and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Ellis, Nel and Chatterjee as applied to claims 1, 16, and 31, and further in view of Toyosawa (US 6,317,793 B1).

Claim 51 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Ellis, Nel and Chatterjee as applied to claim 49, and further in view of Koreeda (US 5,890,137).

All of these rejections are being appealed.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

As claimed, a receiver first receives, from a user, an initiation of a purchase in a receiver 400 connected to a presentation device (e.g., a television) (see page 11, lines 14-19). In response to the initiation of the purchase, software is activated in the receiver 400 (see page 11, lines 14-19). The software causes the receiver 400 to display a purchase screen 606 on the presentation device when the purchase screen 606 is activated by a user (see page 11, lines 14-19). The receiver 400 is also

configured to receive and display broadcast signals on the presentation device (see page 8, lines 3-15). The user may then enter purchase information (for a purchase) into the purchase screen 606 (see page 11, lines 20-29).

The claims further provide that the purchase information identifies an initial television subscription service for an initial activation of the receiver and a television programming package for the receiver (page 11, lines 8-29). As claimed, a user initiates a purchase in a receiver that is connection to a presentation device (e.g., a television) (see page 11, lines 14-19). In response to the receiving, the receiver 400 activates software that is used to display a purchase screen 606 on a presentation device (see page 11, lines 14-19). The receiver 400 is also configured to receive and display broadcast signals on the presentation device (see page 8, lines 3-15). The user may then enter purchase information (for a purchase) into the purchase screen 606 (see page 11, lines 20-29).

The claims further provide that the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver (page 11, lines 8-29). The purchase information is then forwarded, through a secure connection, to a vendor (see page 13, lines 10-23). The vendor transmits a confirmation number and authorization for the initial activation back (i.e., for the initial activation of the receiver and an initial television programming package) to the receiver 400 (see page 13, line 24 - page 14, line 17). The claims specify that the confirmation number confirms that the purchase has been allowed by the vendor. In response (and using the received authorization), the receiver 400 authorizes, activates, and is configured to allow/permit the display of the subscription television service (see page 14, lines 3-28).

Dependent claims 2, 17, and 32 further provide that the purchase screen is activated by a user through a remote control (see page 11, lines 8-19).

Dependent claims 3, 18, and 33 provide specific details regarding the purchase information. Namely, the purchase information comprises a type of credit card, a credit card number, and an expiration date (see Fig. 6, and page 11, lines 20-22).

Dependent claims 4, 19, and 34 provide for additional purchase information that consists of merchandise information for merchandise to be purchased from the vendor (see Fig. 6, and page 11, lines 23-29). In other words, in addition to activating an initial subscription service, the user can also

purchase merchandise.

Dependent claims 5, 20, and 35 provide for further additional purchase information that consists of service information for a service to be purchased from a vendor (see Fig. 6, and page 11, lines 25-29).

Dependent claims 8, 23, and 38 depend on claims 5, 20, and 35 respectively and provide details regarding the interaction with the vendor. Specifically, the authorization for the service is received from the vendor in the receiver 400. Thereafter, the receiver 400 is allowed to display the authorized service (see page 13, line 24-page 14, line 9).

Dependent claims 9, 24, and 39 further provide for verification that all required purchase information has been entered (see page 12, lines 4-9).

Dependent claims 10, 25, and 40 provide further details regarding the establishment of a secure connection set forth in the independent claims. Specifically, a dialtone is obtained through a modem connected to the receiver 400. Thereafter, a phone number (that is stored in the receiver 400) of the vendor is dialed. Once dialed, a secure connection is established with a computer system of the vendor at the phone number dialed. (See page 12, line 10-31).

Dependent claims 11, 26, and 41 provide for displaying on-screen messages that indicate actions being taken by the receiver 400 (see page 12, line 10-page 13, line 27).

Dependent claims 12, 27, and 42 further provide for storing the confirmation number into a purchase history screen in the receiver 400 that allows a customer to view the purchase information (see page 14, lines 18-28).

Dependent claims 13, 28, and 43 indicate that the vendor is a credit card company (see page 17).

Dependent claims 14, 29, and 44 provide that the receiver 400 is an integrated receiver/decoder (IRD) (see page 8, lines 3-6).

Dependent claims 15, 30, and 45 provide that the presentation device is a television (see page 10, line 28).

Dependent claims 46-48 provide that the receiver 400 performs each of the actions automatically without interacting with personnel from the vendor (see page 15, lines 2-9).

Independent claim 49 is similar to dependent claims 1, 16, and 31 but specifically provides

for purchasing a good or service using a credit card (see page 11, lines 20-29).

Dependent claim 50 provides that the vendor receives the confirmation number from a credit card company once a credit card transaction using the credit card information has been processed (see page 14, lines 3-9).

Dependent claim 51 further specifies that the vendor is a credit card company that notifies a service provider of a credit card transaction and the good/service purchased so that the vendor can provide the good/service to the user (see page 14, lines 3-9).

Dependent claim 52 further provides that the good/service is an initial subscription and activation of a television programming package from a broadcaster television provider (page 11, lines 8-29).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-9, 11-24, 26-39, and 41-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis (US 6,275,268 B1) in view of Nel (US 6,363,364 B1) and further in view of Chatterjee (EP 0820206 A2).

Claims 10, 25, and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Ellis, Nel and Chatterjee as applied to claims 1, 16, and 31, and further in view of Toyosawa (US 6,317,793 B1).

Claim 51 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Ellis, Nel and Chatterjee as applied to claim 49, and further in view of Koreeda (US 5,890,137).

All of these rejections are being appealed.

VII. ARGUMENT

A. Claims 1-3, 5, 8, 10-12, 14-18, 20, 23, 25-27, 29-33, 35, 38, 40-42, 44, 45, 51, and 52 are Patentable Over the Cited Art

The Office Action rejects claims 1-9, 11-24, 26-39 and 41-52 under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Nel and in further in view of Chatterjee. Specifically, the

independent claims were rejected as follows:

Claim 1 and related claims 16, 31, and 49 (CURRENTLY AMENDED),

Ellis teaches a method and system of initializing subscription television service comprising:

- a) receiving, from a user an initiation of a purchase in a receiver connected to a presentation device;
- b) in response to the receiving, activating software in the receiver, the software causing the receiver to display on the presentation device, a purchase screen having at least one field, wherein the receiver is further configured to:
 - i) receiver broadcast signals through an input mechanism; and
 - ii) enable the presentation device to display the broadcast signals;
- c) receiving from the user purchase information for a purchase in the at least one field into the receiver, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver;
- d) receiving in the receiver, authorization for the initial activation of the subscription television service for the initial activation of the receiver and initial television programming; and (see at least Abstract, Col. 1, lines 16-20 and 50-55, Col. 26, lines 27-20 and Figures 9-10 and 43C-D). Please note the method and system of Ellis provide the capability to initiate the set top box and package without interacting with a customer service representative. Moreover in a reasonable broad interpretation of the claim language "initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver", Ellis discloses a software in a receiver, which provide the capability to purchase an initial television subscription service such as premium Services to be purchased by credit card, which is not subscribed by the user. Furthermore, this capability of activation of a device such as receiver for decode/communicate after receiving a registration is well known in the art.

While Ellis does disclose transmitting purchase information and credit card authorization, the reference does not specifically disclose a method and system of:

- e) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;
- f) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor;
- g) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor.

On the other hand and in the same area of initializing a subscription television service, Nel teaches a method and system for:

- b) establishing a secure electronic connection using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;
 - i) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor
 - ii) receiving a confirmation number from the vendor into the receiver,
- wherein the confirmation number confirms that the purchase has been allowed by the vendor (see at least Abstract, Col. 3, lines 41-57, Col. 4, lines 4-15, Col. 5, lines and Figures 2-5).

Please note that the receiver in Nel has a dual function such as receive and transmit. Furthermore, in a reasonably broad interpretation of the claim phrase "communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals" is that the transmit portion of the receiver/transmitter, which is different from the receive portion and thereby "different from the input", which is the receiver portion. Thereby, Nel has both a receive portion and different transmit portion, which is different from the input mechanism (i.e. receiver).

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Ellis with the method and system of Nel to have enabled a method and system of initializing a subscription television service comprising:

- a) receiving, from a user an initiation of a purchase in a receiver connected to a presentation device;
- b) in response to the receiving, activating software in the receiver, the software causing the receiver to display on the presentation device, a purchase screen having at least one field, wherein the receiver is further configured to:
 - i) receive broadcast signals through an input mechanism; and
 - ii) enable the presentation device to display the broadcast signals;
- c) receiving from the user purchase information for a purchase in the at least one field into the receiver, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver;
- d) receiving in the receiver, authorization for the initial activation of the subscription television service for the initial activation of the receiver and initial television programming; and
- e) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;
- f) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor;
- g) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor;
- h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services. Ellis discloses the limitations of receiving an initiation of a purchase by a user and the activation of the software to enable receive and display as well as identifying an initial subscription service and activating the receiver (Col. 1, lines 16-20 and 50-55, Col. 26, lines 27-30 and Figures 9-10 and 43C-D).

Nel discloses a method and system for;

- a) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;
- b) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor;
- c) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor (see at least Abstract, Col. 3, lines 41-57, Col. 4, lines 4-15, Col. 5, lines and Figures 2-5). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Ellis with a method and system for;
- d) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;
- e) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor;
- f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor.

The combination of Ellis and Nel disclose and teach substantially the claimed invention.

While the combination does disclose receiving authorization for the subscription of Premier Services, the combination does not specially disclose a method and system for using the received authorization, activating and configuring the receiver to allow the display of the subscription television services.

On the other hand, Chatterjee teaches a method and system for using the received authorization, activating and configuring the receiver to allow the display of the subscription television services (see at least 57, first page). Please note that Chatterjee does not specifically disclose television. However, Chatterjee does disclose using the received authorization, which is associated with the device (transmitter/receiver/decoder) of a mobile phone. In that regard, it would have been obvious to one of ordinary skill in the art to extend the method of Chatterjee with television and thereby have provided additional applications for the method and system, which will also increase the potential revenue for the method and system.

It would have been obvious to one of ordinary skill in the art to have provided the combination of Ellis and Nel with the method and system of Chatterjee to have enabled using the received authorization, activating and configuring the receiver to allow the display of the subscription television services. The combination of Ellis and Nel disclose the claim limitations of receiving, purchasing, displaying and authorizing of a purchase.

Chatterjee discloses a method and system for using the received authorization, activating and configuring the receiver to allow the display of the subscription television services (see at least 57, first page). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Ellis and Nel with a method and system for using the received authorization, activating and configuring the receiver to allow the display of the subscription television services. Thereby, the activation occurs after the authorization to use the device and thereby enhances security for the method and system, which precludes unauthorized users.

Appellants traverse the above rejections for one or more of the following reasons:

- (1) None of the cited references teach, disclose or suggest the initial activation of a subscription television service; and
- (2) None of the cited references teach, disclose or suggest the automated initial activation of a subscription television service without interaction with vendor personnel.

As previously stated, the independent claims provide for the initialization of a subscription television service. As claimed, a receiver is used to display a purchase screen on a presentation device (e.g., a television) when the purchase screen is activated by a user. The receiver is also configured to receive and display broadcast signals on the presentation device. The user may then enter purchase information into the purchase screen. The claims provide that the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver. The purchase information is then forwarded, through a secure connection, to a vendor. The vendor transmits a confirmation number and authorization for the initial activation back to the receiver. In response, the receiver allows/permits the display of the subscription television service by activating and configuring the receiver. All of these interactions are conducted automatically without direct interaction with a phone operator or physical person of the vendor (see dependent claims 46-48).

The above limitations provide the unique ability to order goods/services through a purchase screen displayed on a television screen. The user merely enters the credit card information in the purchase screen and the good/service may be ordered. Further, the use of the credit card information provides substantial flexibility since most users have credit cards. Additionally, the user of a television subscription service (e.g., satellite television broadcasting service) may perform the initial activation of a service without communicating directly with the pay-TV service provider. Thus, the pay-TV personnel required to conduct such processing are not needed. Further, the pay-TV service provider does not need to "float" the money until the customer pays or cover expenses for non-payment of services by the customer.

In this regard, Appellants note that the cited references completely fail to address the unique, novel, and nonobvious aspects of the present invention that relate to the interactions between a user and a set top box. Such interactions enable an end-user to activate a set top box without actually interacting (e.g., on the telephone) with a customer service representative from a broadcast provider. The elimination of such interaction results in a significant cost savings by the broadcast provider (see page 3, lines 22-27 of the present specification). Further, the automated use of the credit cards (as set forth in the claims) eliminates the need for a broadcast provider to manage debt collection since a credit card company can now control and benefit from the credit card used (see page 3, line 28-page 4, line 6).

The primary reference relied upon to reject the claims is Ellis. Appellants again note that the claims specifically provide for the initial activation of both the receiver and an initial television programming package. The Office Action submits that Ellis provides such capability and states that the software in Ellis' receiver can be used to purchase an initial television subscription service such as Premium Services to be purchased by credit card, which is not subscribed to by the user. The Office Action then submits, without support in Ellis or other cited references, that the capability of activation of a device such as a receiver for decode/communicate after receiving a registration is well known in the art.

Appellants respectfully traverse these assertions. The Office Action relies on Ellis col. 1, lines 16-20, 50-55, col. 26, lines 27-20 and figures 9-10 and 43C-D which provide as follows:

Col. 1, lines 12-20 provides:

This invention relates to an electronic program schedule system, which provides a user with schedule information for broadcast or cablecast programs viewed by the user on a television receiver. More particularly, it relates to an electronic program guide that provides the user with the capability to order products and services remotely at the user location simply by depressing a button on a remote control device or other user-controlled device.

Col. 1, lines 50-55 provides:

These prior-art systems also fail to provide the user with sufficient information, for example pricing and the like, about pay-per-view events, premium services or other packaged programming to which the user does not subscribe, nor do they provide the user with the capability to automatically purchase such programming on demand or impulse.

Col. 27, lines 27-30 provides:

Once a preference list is activated, the system will limit the tuning of the television receiver and the display of schedule information only to those channels that are designated in the activated viewer preference list.

Such text illustrates the use of a channel list that the user defines in order to limit the channels the user scrolls through to those channels designated in the user's preference list (see col. 26, lines 14-30).

FIG. 9 shows an impulse ordering menu that appears on a television screen (see col. 6, lines 23-25)

FIG. 10 shows a Premium Services submenu (see col. 6, lines 26-28).

FIGs. 43C-D merely illustrate payment shipping, and order methods for ordering a product (see col. 8, lines 5-7 and col. 34, lines 3-30)

However, as can be seen clearly from the above cited text, the figures, and the remaining text of Ellis, there is no description, explicit or implicit, for the initial activation of a television subscription service, a receiver, or a programming package. Appellants further submit that it is not well known in the prior art to perform such initial activation services. In fact Appellants submit that Ellis is consistent with all of the prior references relied upon in prior rejections in that a relationship has already been established between the user and vendor and there is no description, capability, or acknowledgement of a problem with the initial activation of a receiver and initial subscription package. Ellis consistently relies upon the existing relationship between the vendor and user in its description. For example, the user can elect to view pay-per-view or premium cable services using the remote control (see col. 16, lines 9-21, col. 19, lines 1-65), or to view a channel listing (see col. 17, line 66-col. 18, line 2). In addition, the text of Ellis explicitly acknowledges such a preexisting

relationship and setup of the receiver at col. 20, lines 3-6 which provides:

This submenu indicates to the user that she does not currently subscribe to the selected service, and then asks the user if she would like to order the service. If the user responds affirmatively, the program schedule system takes the user to the ordering submenu discussed above. In this manner, the user can order premium events or services on impulse.

This text clearly indicates that a user has subscribed to various services and a submenu indicates the premium or impulse services the user has not currently subscribed to. In other words, the user can order premium events on impulse beyond what the user has already subscribed to (i.e., the user's/subscriber's regular subscription package).

Col. 20 then continues and describes how the receiver can be used to display billing information that includes a history of purchases charged to the user, current balance information, pending orders, etc. (see col. 20, lines 34-45). Again, such text clearly acknowledges that the receiver has already been setup and a service has already been provided to the user.

Col. 35, lines 34-49 further describe the ability for an existing subscriber to order products and/or services. Thus, a person that already subscribes can order the products and/or services.

Again, Ellis consistently relies upon the existing setup of the receiver and television programming package. There is no mechanism or description in Ellis for performing the initial setup. In other words, as described in the background of the present invention, Ellis is consistent with the prior art in that communication with an actual human customer service representative of the broadcaster would be required to use the system of Ellis.

Without describing or even acknowledging an issue relating to the initial activation of a receiver and initial television programming package, Ellis cannot possibly teach the invention as claimed. Accordingly, Appellants submit that the current independent claims are patentable over Ellis.

In addition, as acknowledged in the Office Action, Ellis fails to describe the use of a confirmation number as set forth in the claims. To reject the confirmation number elements of the claims, the Office Action relies on Nel's Abstract, col. 3, lines 41-57, col. 4, lines 4-15, col. 5 and figures 2-5 of Nel. However, upon a close examination, these cited portions refer to the use of account numbers and personal identification numbers (PIN) to ensure requested data is only displayed on an authorized monitor. Such account numbers and PINs do not provide confirmation

of any transaction or authorization whatsoever. Instead, they are merely numbers that can be used by the user.

With respect to the confirmation aspect of the "confirmation number" claim limitation, Nel merely describes the ability to confirm a transaction. Col. 3, lines 52-57 provides:

The user may similarly instruct fund transfers between accounts to which he may have access at the financial institution and payment of certain other accounts of third parties. Confirmation of the selected instruction, data requested and account balances are visually displayed in real time on the monitor 12, as hereinbefore described.

The claims specifically provide for a "confirmation number". The plain language of the term clearly means a number. Such a "number" is not even remotely suggested by Nel. Instead, Nel merely provides for displaying a confirmation of the selected instruction. Such a confirmation could merely be a message that provides "Fund Transfer Request Received". In fact, Appellants submit that such a text based message is more likely given that it is displayed on the screen for the user to view. In this regard, the mere display of a "number" (as claimed) on a screen without anything else would not provide much use to the user.

In addition to the above, Nel does not teach, describe, suggest, or allude to the use of a number relating to confirmation of a purchase being allowed by a vendor whatsoever. Without even mentioning such a confirmation number, Nel cannot possibly teach, encompass, or render obvious the confirmation number that is specifically claimed. Further, under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." In this regard, the term "number" that is claimed cannot merely be bypassed and ignored. Similarly, the term "confirmation" cannot be separated from the term "number" and merely ignored.

In addition, Nel fails to cure the deficiencies of Ellis. In this regard, Nel also fails to teach receiving, in a receiver, authorization for the initial activation of the initial subscription television service from the vendor. As stated in the background of the present invention, in the prior art, to activate a television subscription service, the customer must call the pay-TV service provider where a series of questions are answered and the customer selects a subscription package. Like Ellis, Nel

also falls within the scope of this prior art. Specifically, there is no capability or description in Nel to perform the initial activation of a pay-TV service or a receiver unit. The claims, in providing this capability, provide significant advantages including the ability for automated activation without a direct communication between a customer and personnel from the pay-TV service.

The Office Action then continues and provides that the combination of Ellis and Nel fails to teach using received authorization, activating, and configuring the receiver. Appellants note that this claim element is closely related to the initial activation elements of the claims and reflects the initial configuration and activation of the receiver and the initial programming package to be displayed on the newly initialized receiver.

To teach these claim elements, the Office Action now relies on Chatterjee. However, the Office Action also admits that Chatterjee does not disclose television and only discloses a transmitter/receiver/decoder of a mobile phone. Appellants submit that the activation of a mobile phone via a switching network as disclosed in Chatterjee is not only completely irrelevant to the present invention, but is not even remotely related to the present invention, Ellis, and/or Nel. Again, the claims provide for activating and configuring the receiver "to allow the display of the subscription television services". Chatterjee's teaching relating to activating a cell phone is in a completely unrelated field of art. Chatterjee's teaching cannot be combined with the present invention to produce an operable result. The MPEP §706.02(j) provides that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." However, there is not suggestion or motivation in Nel, Ellis, or Chatterjee to combine Chatterjee with the cited references. Appellants submit that one skilled in the art of mobile station registrations would not even be remotely tempted to look to television programming services applications and vice versa.

Further, Chatterjee's device cannot be configured to allow the display of television subscription services. Also, Chatterjee's device cannot be configured to allow the display of television subscription services that have been selected by a user through a purchase screen displayed on a presentation device connected to the receiver. In this regard, Chatterjee does not

disclose the system, components, and/or method set forth in the claims, nor their numerous limitations.

In view of the above, Appellants respectfully request reversal of the rejections.

B. Dependent Claims 9, 24, and 39 Are Patentable Over the Cited Art

As described above, these dependent claims provide for verifying that all of the required information has been received. In rejecting these claims, the final Office Action merely recited col. 3, lines 55-57. Col. 3, lines 52-57 provides:

The user may similarly instruct fund transfers between accounts to which he may have access at the financial institution and payment of certain other accounts of third parties. Confirmation of the selected instruction, data requested and account balances are visually displayed in real time on the monitor 12, as hereinbefore described.

Such language (and the remainder of Nel) does not even remotely indicate any verification, confirmation, or validation of whether too little or all of the information that is required to complete a purchase has been received. Instead, this portion of Nel merely provides for confirmation that a selected instruction has been received, followed by a display of data requested and account balances. There is no indication if all of the information to complete a purchase (as claimed) is confirmed merely by confirming receipt of a single particular instruction. In this regard, Nel completely fails to teach the claimed limitations.

C. Dependent Claims 13, 28, 43, and 50 Are Patentable Over the Cited Art

As set forth above, these claims provide that the vendor is a credit card company. Further, claim 50 provides that the confirmation number is received from a credit card company once a credit card transaction using the credit card information has been processed.

In rejecting these claims, the Office Action admits that Nel does not explicitly disclose the limitations. Instead, the Office Action refers to financial transactions that could include account payment. The Office Action further continues and concludes by stating:

...it would have been obvious to one of ordinary skill in the art at the time of the invention to extend the method and system of Nel to have included a vendor, which is a credit card company. In this regard, the credit card company will increase the reasons for using their credit card and thereby increase revenues.

Appellants respectfully disagree with and traverse such an assertion. While credit card companies may always be looking to increase revenue, the specific use of a confirmation number that is transmitted from such a credit card vendor and received into a receiver which indicates the purchase has been allowed by the vendor, is not contemplated or even alluded to, explicitly or implicitly, in Nel or the art. The claims provide for a specific use of a confirmation number received from a credit card vendor. No such coordinates use is taught or described in the cited references. In this regard, under MPEP §2141.01, "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention". The use of Nel in the manner asserted in the Office Action relies on such impermissible hindsight - namely, the reaching of the present invention that utilizes the communication between a credit card company and a receiver to confirm authorization for a purchase for an initial activation of a receiver and television programming package.

Accordingly, Appellants respectfully request reversal of these rejections.

D. Dependent Claims 46-48 Are Patentable Over the Cited Art

These dependent claims provide that the initial activation of the receiver with the initial television subscription package is automated without interacting with personnel from the vendor.

In rejecting these claims, the Office Action relies on Ellis Figures 9 and 10. However, Figures 9 and 10 and the supporting text in Ellis do not even remotely allude to the lack of interaction with personnel from a vendor. Instead, as described above, FIGS. 9 and 10 merely describe the use/ordering of premium services. Such premium services are completely distinguishable and not related to the initial activation and configuration of a receiver and initial television programming package as claimed. The claims specifically provide that all of the actions recited in the claims including the initial activation of the receiver are without interaction with personnel from the vendor. Ellis does not teach, disclose, or suggest, the lack of user interaction with respect to such initial activation services.

Further, there are significant advantages to such initial activation without personnel interaction (as stated above). In fact, such non-personnel based initial activation is not even contemplated or recognized in Ellis or the other cited references.

E. Independent claim 49 Is Patentable Over the Cited Art

As described above, independent claim 49 is similar to dependent claims 1, 16, and 31 but specifically provides for purchasing a good or service using a credit card similar to claims 3, 13, 18, 28, 33, and 43. Accordingly, Appellants reassert the above arguments that address similar claim limitations herein.

F. Conclusion

In light of the above arguments, Appellants respectfully submit that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellants' claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

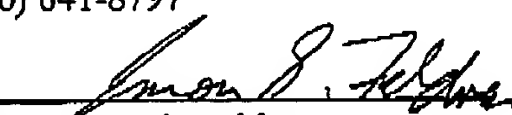
Respectfully submitted,

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APPENDIX

1. A method of initializing a subscription television service comprising:
 - (a) receiving, from a user, an initiation of a purchase in a receiver connected to a presentation device;
 - (b) in response to the receiving, activating software, in the receiver, the software causing the receiver to display, on the presentation device, a purchase screen having at least one field, wherein the receiver is further configured to:
 - (i) receive broadcast signals through an input mechanism; and
 - (ii) enable the presentation device to display the broadcast signals;
 - (c) receiving, from the user, purchase information for a purchase, in the at least one field into the receiver, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver;
 - (d) establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism that is used to receive broadcast signals, with a vendor;
 - (e) electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor;
 - (f) receiving a confirmation number from the vendor into the receiver, wherein the confirmation number confirms that the purchase has been allowed by the vendor;
 - (g) receiving, in the receiver, authorization for the initial activation of the subscription television service for the initial activation of the receiver and initial television programming package; and
 - (h) using the received authorization, activating and configuring the receiver to allow the display of the subscription television services.
2. The method of claim 1 wherein the activation of the purchase screen is received from the user using a remote control.
3. The method of claim 1 wherein the purchase information further comprises:

a type of credit card;
a credit card number; and
an expiration date.

4. The method of claim 1, further comprising receiving additional purchase information, wherein the additional purchase information comprises merchandise information for merchandise to be purchased from the vendor.

5. The method of claim 1, further comprising receiving additional purchase information, wherein the additional purchase information comprises service information for a service to be purchased from the vendor.

6. (CANCELED)

7. (CANCELED)

8. The method of claim 5 further comprising:
receiving, in the receiver, authorization for the service from the vendor; and
configuring the receiver to allow the display of the authorized services.

9. The method of claim 1 further comprising verifying that all of the required purchase information has been received.

10. The method of claim 1 wherein establishing a secure electronic connection comprises:

obtaining a dialtone through a modem connected to the receiver;
dialing a phone number corresponding to the vendor selected, wherein the phone number is stored in the receiver; and
establishing a secure connection with a computer system of the vendor at the phone number dialed.

11. The method of claim 1 further comprising causing one or more onscreen messages to be displayed that indicate actions being taken by the receiver.

12. The method of claim 1 further comprising storing the confirmation number into a purchase history screen in the receiver that allows a customer to view the purchase information.

13. The method of claim 1 wherein the vendor is a credit card company.

14. The method of claim 1 wherein the receiver is an integrated receiver/decoder (IRD).

15. The method of claim 1 wherein the presentation device is a television.

16. A system for initializing a subscription television service comprising:
a receiver configured to:

receive broadcast signals through an input mechanism

enable a presentation device connected to the receiver to display the broadcast signals;

receive, from a user, an initiation of a purchase;

in response to the initiation of the purchase, activate software that causes the receiver to display, on the presentation device, a purchase screen having at least one field;

receive, from the user, purchase information for a purchase, in the at least one field, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television programming package for the receiver;

establish a secure electronic connection, using a communication mechanism that is different from the input mechanism that is used to receive broadcast signals, with a vendor;

electronically transmit the purchase information through the secure electronic connection to the vendor;

receive a confirmation number from the vendor, wherein the confirmation number confirms that the purchase has been allowed by the vendor;

receive authorization for the initial activation of the subscription television service for the initial activation of the receiver and the initial television programming package; and

use the received authorization to activate and configure the receiver to allow the display of the subscription television services.

17. The system of claim 16 wherein the receiver is configured to receive the activation of the purchase screen from the user using a remote control.

18. The system of claim 16 wherein the purchase information further comprises:
a type of credit card;
a credit card number; and
an expiration date.

19. The system of claim 16 wherein the receiver is configured to receive additional purchase information that comprises merchandise information for merchandise to be purchased from the vendor.

20. The system of claim 16 wherein the receiver is configured to receive additional purchase information that comprises service information for a service to be purchased from the vendor.

21. (CANCELED)

22. (CANCELED)

23. The system of claim 20, the receiver further configured to:
receive authorization for the service from the vendor; and
allow the display of the authorized services.

24. The system of claim 16, the receiver further configured to verify that all of the required purchase information has been received.

25. The system of claim 16 wherein the receiver is configured to establish a secure electronic connection by:

obtaining a dialtone through a modem connected to the receiver;

dialing a phone number corresponding to the vendor selected, wherein the phone number is stored in the receiver; and

establishing a secure connection with a computer system of the vendor at the phone number dialed.

26. The system of claim 16, the receiver further configured to cause one or more onscreen messages to be displayed that indicate actions being taken by the receiver.

27. The system of claim 16, the receiver further configured to store the confirmation number into a purchase history screen in the receiver that allows a customer to view the purchase information.

28. The system of claim 16 wherein the vendor is a credit card company.

29. The system of claim 16 wherein the receiver is an integrated receiver/decoder (IRD).

30. The system of claim 16 wherein the presentation device is a television.

31. An article of manufacture for initializing a subscription television service comprising:
means for a receiver connected to a presentation device to receive broadcast signals through an input mechanism;

means for the receiver to enable the presentation device to display the broadcast signals;

means for the receiver to receive, from a user, an initiation of a purchase;

means for the receiver, in response to the initiation of the purchase, activate software in the receiver, wherein the software causes the receiver to display, on the presentation device, a purchase screen having at least one field;

means for the receiver to receive, from the user, purchase information for a purchase in the one or more fields, wherein the purchase information identifies an initial television subscription service for an initial activation of the receiver and an initial television program package for the receiver;

means for the receiver to establish a secure electronic connection, using a communication mechanism that is different from the input mechanism that is used to receive broadcast signals, with a vendor;

means for the receiver to electronically transmit the purchase information through the secure electronic connection to the vendor;

means for the receiver to receive a confirmation number from the vendor, wherein the confirmation number confirms that the purchase has been allowed by the vendor;

means for receiving, in the receiver, authorization for the initial activation of the subscription television service for the initial activation of the receiver and the initial television programming package; and

means for using the received authorization to activate and configure the receiver to allow the display of the subscription television services

32. The article of manufacture of claim 31 wherein the activation of the purchase screen is received from the user using a remote control.

33. The article of manufacture of claim 31 wherein the purchase information further comprises:

- a type of credit card;
- a credit card number; and
- an expiration date.

34. The article of manufacture of claim 31, further comprising means for receiving additional purchase information, wherein the additional purchase information comprises merchandise information for merchandise to be purchased from the vendor.

35. The article of manufacture of claim 31, further comprising means for receiving additional purchase information, wherein the additional purchase information comprises service information for a service to be purchased from the vendor.

36. (CANCELED)

37. (CANCELED)

38. The article of manufacture of claim 35 further comprising:
means for the receiver to receive authorization for the service from the vendor; and
means for the receiver to allow the display of the authorized services.

39. The article of manufacture of claim 31 further comprising means for verifying that all of the required purchase information has been received.

40. The article of manufacture of claim 31 wherein the means for the receiver to establish a secure electronic connection comprises:
means for the receiver to obtain a dialtone through a modem connected to the receiver;
means for the receiver to dial a phone number corresponding to the vendor selected,
wherein the phone number is stored in the receiver; and
means for the receiver to establish a secure connection with a computer system of the vendor at the phone number dialed.

41. The article of manufacture of claim 31 further comprising means for the receiver to cause one or more onscreen messages to be displayed that indicate actions being taken by the receiver.

42. The article of manufacture of claim 31 further comprising means for the receiver to store the confirmation number into a purchase history screen in the receiver that allows a customer to view the purchase information.

43. The article of manufacture of claim 31 wherein the vendor is a credit card company.

44. The article of manufacture of claim 31 wherein the receiver is an integrated receiver/decoder (IRD).

45. The article of manufacture of claim 31 wherein the presentation device is a television.

46. The method of claim 1 wherein all of the steps are automated without interacting with personnel from the vendor.

47. The system of claim 16 wherein the receiver is configured to perform the actions automatically without interacting with personnel from the vendor.

48. The article of manufacture of claim 31 wherein all of the means automatically perform the indicated actions without interacting with personnel from the vendor.

49. A method of making a purchase comprising:
activating, in a receiver connected to a presentation device, a purchase screen having at least one field, wherein the receiver is configured to:
receive broadcast signals through an input mechanism; and
enable the presentation device to display the broadcast signals;
the activation enabling the purchase screen to be displayed on the presentation device;
receiving purchase information in the at least one field into the receiver from a user, wherein the purchase information comprises credit card information and a good or service;

establishing a secure electronic connection, using a communication mechanism of the receiver that is different from the input mechanism, with a vendor;
electronically transmitting the purchase information from the receiver through the secure electronic connection to the vendor;
receiving a confirmation number from the vendor into the receiver.

50. The method of claim 49 wherein the vendor receives the confirmation number from a credit card company once a credit card transaction using the credit card information has been processed.

51. The method of claim 49 wherein:
the vendor is a credit card company; and
the vendor notifies a service provider of a credit card transaction and the good or service purchased to provide the good or service to the user.

52. The method of claim 49 wherein the good or service comprises an initial subscription and activation of a television programming package from a broadcasting television provider.